



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Chang *et al.*

Appl. No. 10/765,568

Filed: January 28, 2004

For: **Method for evaluating the efficacy
of certain cancer treatments**

Confirmation No.: 8131

Art Unit: 1642

Examiner: Halvorson, M.

Atty. Docket: 2474.0100001/BJD/JKM

Reply to Election of Species

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Election of Species requirement dated **December 27, 2006**,

Applicants hereby provisionally elect the following Species:

- (i)(a) one therapeutic agent;
- (i)(a)(III) a nucleic acid;
- (i)(a)(III)(A) a wild type p53 molecule;
- (ii)(c) an antibody or antibody fragment; and
- (ii)(c)(I) an anti-transferrin antibody.

Each of these elections is made **with traverse**. Claims 1-18 read on each of these species.

During a telephone conversation on January 19, 2007, between the Examiner and Applicants' undersigned representative, it was noted that the Office Communication, dated

December 27, 2006, contained an error as the Election stated that "claim[] 5 is generic to a plurality of patentably distinct *inventions*" (emphasis added). The Examiner acknowledged that this language was in error, and should read as an election of *species* and **not** an election of patentably distinct inventions. Hence, all elections required in the Office Communication, and all elections set forth above, are *species* elections.

According to M.P.E.P. Section 803: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 at 800-4. The subject matter of each allegedly distinct Species is clearly related, as all of the species are useful in the presently claimed methods for evaluating the efficacy of a therapeutic agent that acts to induce apoptosis. Therefore, searching these groups together would not place a serious burden on the Examiner within the meaning of M.P.E.P Section 803. In view of the comments presented above, Applicants respectfully request reconsideration of the Election of Species requirement, and that the species identified by the Examiner be examined together.

In accordance with 37 C.F.R. § 1.1141(a), Applicants reserve the right to claim additional species, and/or to have additional species searched and/or examined, in the event that a generic claim is found to be allowable.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such

extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: February 27, 2007

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